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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/058,140

01/29/2002

Takafumi Taguchi

1403-0223P

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09/21/2004

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EXAMINER

KNABLE, GEOFFREY L.

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------|----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/058,140 | TAGUCHI ET AL. | |
| | Examiner | Art Unit | |
| | Geoffrey L. Knable | 1733 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-3, 5 and 8-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 defines that the second rubber composition consists of "at least one diene rubber..." Although this language essentially incorporates the substance of previous claim 4, upon reconsideration, it is not considered that this was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter. In other words, while the original disclosure does describe that the second composition can be formed from a diene rubber, which can be selected from the recited group, it never describes the second rubber composition consisting of "at least one" of these diene rubbers. This same lack of description/new matter is also present in new claim 12.

Note that since the amendment did not necessitate this rejection, this action will not be made final.

2. Claims 1-3, 5 and 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 defines the rubber components of the first rubber composition using the normally closed language "consisting of" and also now defines the second rubber

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composition using the normally closed language "consisting of" followed by a list of components. New dependent claims 8-10 however then define that the second rubber composition can contain other materials beyond those mentioned in claim 1. Further, new claim 11 defines that the "only rubber component" of the first composition consists of the same components described in claim 1. Thus, although claim 1 seemed to use closed language, the presence of these dependent claims, which would seem to evidence that claim 1 is not to be read as in fact excluding other components, raises significant confusion in assessing the scope of protection afforded by these claims and as such, the scope of what is and is not excluded by these claims is considered to be indefinite. Since this same language is used in new claim 12, the scope of this claim is likewise considered to be indefinite and confusing.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-3, 5 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koch et al. (US 3,038,515) taken with the excerpted Exxon technical article, Gessler et al. (US 4,014,852) and (optionally) GB 2,072,576 to Exxon (Hous et al.) as applied in the last office action.

As to the new limitations on the diene rubber in the second rubber compositions, Koch et al. only includes GRS (i.e. styrene-butadiene rubber) and thus satisfies this new limitation. As to the other restrictions on the composition for the rubber layer, for reasons noted in the 112 rejection above, the claim cannot at present be read to exclude other materials such as for example the silica in Koch et al. Further, even if so

read, it is noted that Koch et al. seems to contemplate that the silica need only be added to "one of the rubbery components of the laminate" (col. 1, lines 26-30) or by "incorporating silica in one of the layers" (col. 1, lines 36-40). As such, it is considered that this reference would have been read by the artisan as including teachings of a tire in which the silica need not be added to the GRS layer (i.e. added only to the butyl layer) and as such, bonding of a butyl liner to the carcass using a GRS layer without silica is disclosed or certainly obvious from these teachings.

As to new claims 8-10, it is noted that Koch et al. discloses that ingredients such as softeners (this being considered to read on the claimed "workability-increasing ingredient," process oil being an extremely well known such additive in this art) may be used (col. 3, lines 50+). Further, the reference clearly indicates that the artisan would have been able to select appropriate vulcanizing agents (col. 4, lines 49+), it further being stressed that the exemplary compositions includes zinc oxide as claimed (col. 2, lines 55+). As to cobalt salt, use of such in any rubber composition that is adjacent to steel cords is extremely well known in this art to enhance cord bonding and use of such for any composition that is near such steel cords would have been obvious to assure there is no undue diffusion out of an adjacent cord containing layer (and therefore causing reduced adhesion), the diffusion of ingredients among layers being well known and well characterized in this art.

5. Claims 1-3, 5 and 8-12 are rejected under 35 U.S.C. 103 as being unpatentable over Koch et al. (US 3,038,515) taken with Berta (US 4,616,686) and Berta (US 4,587,302) as applied in the last office action.

As to the new claims, the above discussion in the preceding paragraph is equally applicable here and is therefore incorporated here by reference.


6. Applicant's arguments filed 6-24-2004 have been fully considered but they are not persuasive.

Applicant stresses that the claims have been amended to clearly exclude silica. For reasons noted above, however, it is not considered that the claims clearly exclude silica and in fact, the new claims evidence that the claims do not in fact exclude other components. Further, and in any event, note also the new portions of the Koch et al. reference noted above seem to indicate that the reference contemplated the silica in one of either the butyl or the GRS layer and thus would seem to have contemplated and therefore taught a GRS layer that would not include silica.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
September 20, 2004